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EXAMINER

RUSSEL, JEFFREY E

ART UNIT PAPER NUMBER

1654

DATE MAILED 02 27 2003

Please find below and or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/904 352

Examiner

Jeffrey E. Russel

Applicant(s)

BORDERS ET AL

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)  
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3. ☐ Information Disclosure Statement(s) (PTO-1449, Paper No(s) \_\_\_\_\_)  
4. ☐ Interview Summary (PTO-413, Paper No(s) \_\_\_\_\_)  
5. ☐ Notice of Informal Patent Application (PTO-152)  
6. ☐ Other \_\_\_\_\_

1. Claims 37, 44-48, and 72-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 defines a variable,  $S^2$ , which is not used in any of the structural formulas in the claims. There is no antecedent basis in the claim for the phrase "the laspartomycin core peptide derivative" at claim 44, lines 4-5. It is believed that "the" should be changed to "a" in the phrase. It is also believed that "derivative" should be deleted from the phrase, because the derivative is not formed until after the lipophilic-linker group is attached. Claim 72 refers to "a compound according to Claim 48", however, claim 48 is drawn to a laspartomycin derivative, not a compound. For analogous reasons, claims 73-77 and 79 are also indefinite. Claim 78 refers to "a compound according to Claim 75"; however, claim 75 is drawn to a method, not a compound. It is believed that the dependency of claim 78 is incorrect.

2. Claims 29, 32-34, 40-48, 50, 53-55, 72, 75, and 78 are objected to because of the following informalities. Claims 29, 34, 50, and 55 do not end with periods. In claims 32 and 53, structures (L3) and (L4), each occurrence of " $S_1$ " should be changed to " $S^1$ ", consistent with the terminology used elsewhere in the structures and the claims. At claim 40, lines 1 (second occurrence) and 5, and claim 44, lines 1 (second occurrence) and 5, "a" should be changed to "an". Appropriate correction is required.

3. Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. At claim 32, line 2, it is believed that " $-CO_2R$ " should instead be

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"-CO<sub>2</sub>R<sup>1</sup>", because claim 30, upon which claim 32 ultimately depends, does not recite a substituent "-CO<sub>2</sub>R<sup>1</sup>".

4 Claims 42, 43, 46, and 47 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to other claims in the alternative only. Note, for example, that claim 42 is dependent upon both claim 40 and upon any one of claims 1, 23, and 24. See MPEP § 608.01(n), especially section (I)(B)(3).

5 Claims 73 and 77 are identical in scope. Upon an indication of allowability, one of these claims will be rejected over the other consistent with the procedures of MPEP 706.03(k). In order to expedite prosecution of this application, it is suggested that one of these two claims be amended or canceled in the response to this Office action.

6 A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894), *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957), and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15, 19-41, 44, 45, 48-73, and 75 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-33 and 35-68 of prior U.S. Patent No. 6,511,962. This is a double patenting rejection.

7 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), *In re Van Ornum*, 686

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F 2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F 2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-18, 42, 43, 46, 47, 74, and 76-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of U S Patent No. 6,511,962. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '962 patent anticipate the instant claims.

8 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014, for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.

Jeffrey E. Russel  
Primary Patent Examiner  
Art Unit 1654

JRussel  
February 26, 2003